

REMARKS:

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This communication is in response to the Final Office Action mailed January 27, 2005 (paper 20) and to an Examiner Interview of March 22, 1005. Claims 1-35 are pending in this application. Claims 1-35 have been previously presented.

Rejections under 35 U.S.C. §112

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Claim 34 was rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states “support for the new limitation ‘occurred prior to’ was not found.”

The Applicants believe that the following sections of the application as filed provide support for “occurred prior to” as recited in Claim 34.

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First, at page 13 lines 10-11 the application as filed reads “Fig. 4 illustrates an example of such user-guided behavior. It can be seen from Fig. 3 that the user selected donor 215 to place in the middle slot of Equipment Frame 1.” The Applicants respectfully point out that in this sentence donor 215 is characterized as having been “selected” “to place.” That the selection has already occurred is indicated by the use of

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the past tense in the word “selected.” That the placement has not yet occurred is indicated by the use of the future tense in the phrase “to place.” Thus, this sentence teaches that the selection occurs before the placement. Because, in some embodiments, selection of a slot occurs on placement of the object in the slot (e.g., see page 9 lines 20 through page 10 line 3), it is the Applicants’ position that this teaches “*the selection of one of the plurality of selectable objects occurs prior to the selection of one of the plurality of slots,*” as recited in Claim 34.

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Second, Fig. 4 illustrates an act of moving a selected object over a slot. Here the object has already been selected and, as it is being moved, has yet to be placed. As described at page 13 lines 11-13, “as the object moves over the middle slot of Equipment Frame 1, the user receives an indication that this placement is not permissible, as it would result in a violation of the forward-looking rules.” The Applicants maintain that the object must already have been selected in order to be moved and, as shown in Fig. 4, it has yet to be placed in a slot. Thus, Fig. 4 teaches that selection of an object occurs before placement. It is the Applicants’ position that this teaches “*the selection of one of the plurality of selectable objects occurs prior to the selection of one of the plurality of slots,*” as recited in Claim 34.

Third, Figs. 6 and 7 illustrate a process of dragging an object and, after dragging the object, dropping it in a slot. A detailed explanation of the drag-and-drop process is provided on page 9 of the specification as filed. In Fig. 6 the object has been selected. Selection of an object is required to move an object in the GUI of Fig. 6. However, it has yet to be placed in a slot. Specifically, at page 14 lines 3-4, of the specification as filed, it is taught that “[t]he action is not complete until she drops the object somewhere, be it in another slot or in the trash.” Thus, selection of an object has occurred but selection of a slot has not yet occurred. In Fig. 7 the previously selected object is shown dropped in a selected slot. As taught at page 14 line 4, “[i]n figure 7 the user has completed the action and dropped the object 610 in another slot.” Therefore, Figs. 6 and 7 illustrate an example in which an object is first selected, and then a slot is selected in which to place the previously selected object. It is the Applicants’ position that this teaches “*the*

selection of one of the plurality of selectable objects occurs prior to the selection of one of the plurality of slots,” as recited in Claim 34.

Finally, Claim 31 recites in part “*selecting the first of the one or more slots by dragging the first of the plurality of objects to the first of the one or more slots, within the graphical user interface.*” Here, in order to select a slot an object is dragged to the slot. However, to be dragged an object must first be selected. Thus, selection of an object occurs before selection of a slot. It is the Applicants’ position that this teaches “*the selection of one of the plurality of selectable objects occurs prior to the selection of one of the plurality of slots,*” as recited in Claim 34.

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Rejections under 35 U.S.C. §101

Claim 34 was rejected under 35 USC 101 as being directed toward non-statutory subject matter. Claim 34 recites:

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34. The method of claim 1, wherein the selection of one of the plurality of selectable objects occurred prior to the selection of one of the plurality of slots.

In the Final Office Action of January 27, 2005, the Examiner states:

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[T]he method claimed in claim 34 is not embodied on a computer readable medium. Methods not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ 2d at 1760 (claim to a data structure per se held nonstatutory).

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See MPEP § 2106 (IV.1.a)

The Applicants traverse this statement.

First, the Applicants have reviewed the section of the MPEP referred to by the Examiner, which is assumed to be § 2106.IV.B.1(a), and is unable to find support for the Examiner's statement that "[m]ethods not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer." Specifically, while the cited MPEP section states "[d]ata structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer," and "computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are [non-statutory]," neither of these statements appear to be applicable to "methods" in general as suggested by the Examiner. Therefore, the Applicants request that the Examiner provide support for his statement that "[m]ethods not claimed as embodied in computer-readable media are descriptive material per se," or allow Claim 34.

Second, unlike the data structures and program listings discussed in § 2106.IV.B.1, there at least are two actions referred to in Claim 34 that result in functional changes in the operation of a computer. Specifically, both "*selection of one of the plurality of selectable objects*" and "*selection of one of the plurality of slots*" include a change in a computer's state and thus a functional change in the computer. Thus, the method of Claim 34 produces a "useful, concrete and tangible result" and is statutory subject matter. The Examiner is referred to *State Street*, 149, F3d at 1373, 47 USPQ2d at 1601-02 for support that an invention that produces a "useful, concrete and tangible result" is statutory subject matter under §101.

Third, the section of the MPEP referred to by the Examiner is entitled “(a) Functional Descriptive Material: ‘Data Structures’ Representing Descriptive Material *Per Se* or Computer Programs Representing Computer Listings *Per Se*.” Thus, this section appears to be only applicable to “data structures” and “computer listings *per se*.”

5 In contrast, Claim 34 recites a method including a temporal relationship between two actions, and is thus not a “data structure,” as suggested by the Examiner. Neither is Claim 34 a “computer listing *per se*.” Thus, it is not clear to the Applicants how the Examiner believes the cited MPEP section supports the rejection of Claim 34 under 35 USC § 101. The Applicants, therefore, request that the Examiner provide support for the
10 rejection, or allow Claim 34.

Finally, MPEP § 2106.II.A states

15 [o]ffice personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. ... Further when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection. (emphasis added)

20 It is the Applicants’ position that the Examiner has not overcome the above burden to establish a *prima facie* case for rejection under 35 U.S.C. 101. First, a practical result of configuring a product is achieved by the method claimed in Claim 34, and Claim 1 from which it depends. Second, the Examiner has not yet expressly stated “how the language of the claims has been interpreted to support the rejection,” as required by the MPEP.

25 Further, in the Final Office Action of January 27, 2005, the Examiner states:

[T]he method claimed in claim 34 is a non-descriptive data structure. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process,

machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. See MPEP § 2106 (IV.1.b)

The Applicants traverse this statement. First, Claim 34 does not recite “a non-
5 descriptive data structure.” Rather it recites a temporal relationship between two actions
recited in Claim 1. On this basis alone, the cited MPEP section does not appear to be
applicable. Second, because Claim 34 recites a temporal relationship between actions,
Claim 34 does characterize a functional interrelationship in the way a computing process
is performed, e.g., one action is performed before another. The Examiner is reminded
10 that, per MPEP § 2106.IV.B.1(b), “[o]ffice personnel should consider the claimed
invention as a whole to determine whether the necessary functional interrelationship is
provided.”

Further, in rejecting Claim 34 under 35 U.S.C. §101 the Examiner characterizes
the method of Claim 34 as “descriptive material per se” as a basis for applying
15 § 2106.IV.B.1(a). Then, in the next paragraph, the Examiner characterizes the same
method of Claim 34 as “a non-descriptive data structure” as a basis for applying §
2106.IV.B.1(b). The Applicants respectfully point out that the positions taken by the
Examiner are mutually contradictory.

For at least the reasons discussed above, the Applicants request that the Examiner
20 clarify his rejection of Claim 34 under 35 U.S.C. §101, or allow Claim 34.

Rejections under 35 U.S.C. §102

**Claims 1-3, 6-9, 14-17, 23-30, 32 and 33 were rejected under 35 U.S.C. 102(b)
as being anticipated by Henson, US Patent 6,167,383, filed 09/22/1998.**

Regarding Claim 1.

Claim 1 recites:

1. *A method for visually configuring a product by placing a plurality of selectable components into a plurality of slots, comprising:*
- (a) initializing a configuration layout with proper state;*
 - (b) receiving a selection of one of the plurality of selectable objects, and of one of the plurality of slots in which the selected object may be placed;*
 - (c) providing visual feedback indicating a validity of the selections;*
 - (d) receiving a placement of the selected object;*
 - (e) receiving input regarding the placement from a remote inference engine;*
 - (f) updating the visual feedback as needed based on the received input; and*
 - (g) repeating steps (b) through (f) until no more selections are received.*

Claim 1 was discussed in the Examiner Interview of March 22, 2005. This discussion focused primarily on the limitations “*one of the plurality of slots in which the selected object may be placed*” and “*receiving a placement of the selected object.*”

With regard to “*one of the plurality of slots in which the selected object may be placed,*” the Applicants clarified the point that a “*plurality*” means that there is more than one. Thus, “*the plurality of slots in which the selected object may be placed*” requires that there be more than one slot in which “*the selected object*” may be placed. In the Examiner Interview, the Examiner concurred that this limitation was not taught by those sections of Henson already cited by the Examiner. Therefore, the arguments previously presented by the Applicants have not been fully addressed. On these grounds the Applicants request that the finality of the current office action be withdrawn and a new non-final office action be issued, or Claim 1 be allowed.

The above point had previously been argued on page 13 line 18 through page 14 line 16 of the Response to Office Action filed September 15, 2004. With the utmost respect, the Applicants suggest that Examiner reconsider these arguments. The Applicants also note that similar limitations are found in Claims 2, 12, 14, 15 and 16.

With regard to the limitation “*receiving a placement of the selected object*,” the Applicants pointed out that while Henson teaches selection of an object there does not appear to be any teaching that could be interpreted as “*receiving a placement*.” This was previously pointed out on page 12 line 25 through page 13 line 17 of the Response to Office Action filed September 15, 2004. As discussed in the Examiner interview, this claim element can be divided into at least two aspects: (a) a receiving event and (b) “*a placement of the selected object*.” It is the position of the Applicants that neither of these are found in the cited art. As further discussed in the Examiner Interview, understanding of this position is assisted by realizing that “*placement*” and “*selection*” are separate steps as recited in Claim 1. Thus, the process of “*selection*” should not be confused with the process of “*placement*.” Specifically, the “*selection*” process occurs in step “(b)” of Claim 1, while the “*placement*” is recited in separate step “(d).”

During the Examiner Interview the Examiner suggested that “*receiving a placement of the selected object*” included ambiguous language because it was not clear what a “*placement*” was. The Applicants believe that this language is not ambiguous in light of the specification as filed. For example, Figs. 3-7 show a process by which an object is dragged across a graphical user interface and *placed* in a slot. While, as the Examiner has pointed out, one cannot read limitations from the specification into the claims, it is possible to refer to the specification in order to provide meaning to terms used in the claims. In this case, it is the Applicants’ position that the specification properly characterizes the term “*placement*” and that given this characterization the wording is not ambiguous. It is, thus, the position of the Applicants that there is no “*placement of the selected object*” taught in Henson, much less a “*received*” placement.

For at least the above reasons the Applicants request that the Examiner allow Claim 1 and Claims 33 and 34 that depend therefrom.

Regarding Claim 2.

Claim 2 recites:

- 5 2. A method for visually configuring a product by placing a plurality of selectable components into a plurality of slots, comprising:
- (a) initializing a configuration layout with proper state;
 - (b) receiving a selection of one of the plurality of selectable objects, and of one of the plurality of slots in which the selected object may be placed;
 - 10 (c) looking up a set of constraints on the placement of the selected object;
 - (d) receiving a placement of the selected object;
 - (e) receiving input regarding the placement from a remote inference engine;
 - (f) implementing the received input;
 - (g) storing a new set of constraints based on the placement of the selected object;
 - 15 and
 - (h) repeating steps (b) through (g) until no more selections are received.

Claim 2 was discussed in the Examiner Interview of March 22, 2005. During this discussion the Applicants' representative maintained that the shopping cart of Henson could not be equated with the "constraints" of Claim 2, as had previously been suggested by the Examiner. This point was previously discussed on page 15 line 23 through page 16 line 8 of the Response to Office Action filed September 15, 2004, to which the Examiner is respectfully referred. Briefly, it is the position of the Applicants that "constraints" are rules regarding what objects can be combined in a product. Further, "constraints" are something that can be violated (see page 13 line 19 of the specification as filed). In contrast, the items saved with the shopping cart of Henson are merely items selected for purchase (see Col. 10 lines 52-53). These are not constraints because, among other reasons, they are not rules that can be considered to be violated or not violated.

It is also the position of the Applicants that Claim 2 should be allowed for at least the reasons discussed above with respect to Claim 1.

Regarding Claims 3 and 6-8.

It is the Applicants' position that Claims 3 and 6-8 should be allowed for at least the same reasons discussed above with respect to Claim 2.

Regarding Claim 9.

5 Claim 9 recites:

*A system for visually configuring a product from a plurality of selectable components, comprising:
a user interface for displaying the plurality of selectable components and a plurality of slots into which the plurality of selectable
10 components can be placed; and
a user intelligence communicatively coupled to the user interface, for receiving a set of constraints from a remote inference engine and implementing the set of constraints.*

15 Claim 9 was discussed in the Examiner Interview of March 22, 2005. During this discussion the Applicants' representative maintained that "*a user intelligence*" was a physical element of the claimed system and could not be equated with an implied human user of the system taught in Henson as suggested by the Examiner in paragraph 50 of the Final Office Action mailed January 27, 2005. The Applicants' representative and the
20 Examiner agreed that the Examiner would discuss this point with a Supervising Patent Examiner.

The Applicants believe that the term "*user intelligence*" is used, for example, to refer to logic that is on a user's side of a client-server architecture. The Examiner is referred to Fig. 1, which illustrates an embodiment in which "User intelligence 140"
25 includes "Forward-looking rules table Storage 150," "Forward-looking rules implementor 155," "Forward-looking rule table Interpreter 145," and "Encoder of implementation 160." These are not elements of a human user of the system of Henson. The term "*user intelligence*" is also used to distinguish logic from "server side intelligence" a phrase

which is also used in the specification as filed to distinguish server side logic, for example on page 10 line 5.

Further, although not discussed in the Examiner Interview of March 22, 2005, it is the Applicants' position that Henson does not teach "*a user intelligence communicatively coupled to the user interface, for receiving a set of constraints from a remote inference engine.*" In the Response to Office Action filed September 15, 2004 the Applicants' representative maintained that the "*user intelligence*" cannot be equated with the configurator, cart, checkout and database of Henson because of certain features of the "*user intelligence*" that were pointed out by the Applicants (see page 17 lines 10-20). In response, the Examiner pointed out that limitations from the specification cannot be read into the claims. The Applicants understand this general principle, however, the language of the specification pointed out by the Applicants was for the purpose of adding definition to the term "*user intelligence*" and differentiating that definition from the teachings of Henson, rather than to add limitations to the claim. The Applicants respectfully request that the Examiner revisit page 17 lines 10-20 of the September 15, 2004 Response to Office Action in order to appreciate the definition of "*user intelligence.*"

Further, although not discussed in the Examiner Interview of March 22, 2005, it is the Applicants' position that Henson does not teach "*a user intelligence*" that is "*remote*" from an "*inference engine.*" The Examiner is respectfully referred to page 17 line 21 through page 18 line 2 of the Response to Office Action Filed September 15, 2004 for a more detailed explanation of this further point of distinction.

It is also the Applicants' position that Claim 9 should be allowed for at least reasons discussed above with respect to Claim 1.

Regarding Claim 14.

It is the Applicants' position that Claim 14 should be allowed for at least the same reasons discussed above with respect to Claim 1.

Regarding Claim 15.

It is the Applicants' position that Claim 15 should be allowed for at least the same reasons discussed above with respect to Claim 2.

Regarding Claim 16.

Claim 16 recites:

16. A method of visually configuring a product by placing one or more of a plurality of objects into one or more slots, subject to a plurality of configuration rules, the method comprising:

- (a) providing the plurality of objects and a predetermined product configuration layout to a client device for display within a graphical user interface, the product configuration layout including the one or more slots;*
- (b) receiving, from the client device, a selection of one of the plurality of objects displayed within the graphical user interface and a selection of one of the one or more slots, the selection of the one of the plurality of objects and the selection of one of the one or more slots being for modification of the product configuration layout;*
- (c) causing the graphical user interface to indicate that the selected object cannot be placed in the selected slot, if placing the selected object in the selected slot would violate one or more of the plurality of configuration rules; and*
- (d) causing the graphical user interface to show the selected object within the selected slot, if placing the selected object in the selected slot would not violate any of the plurality of configuration rules.*

Due to time constraints the Applicants' representative and the Examiner were only briefly able to discuss Claim 16 during the Examiner Interview of March 22, 2005.

The Applicants' representative pointed out that there is no teaching in Henson for indicating to a user when a selected object cannot be placed in a selected slot, and thus

Henson does not teach “*indicat[ing] that the selected object cannot be placed in the selected slot.*” The Applicants further pointed out the large “X”s shown in Figs. 4-6 of the specification as filed as examples of an indication, in order to assist with the Examiner’s understanding of the claim language.

5 During the Examiner Interview the Examiner was not able to point out specific teaching in Henson of the above claim. Therefore, the Applicants maintain their position that Henson does not teach “(c) *causing the graphical user interface to indicate that the selected object cannot be placed in the selected slot, if placing the selected object in the selected slot would violate one or more of the plurality of configuration rules,*” as recited
10 in Claim 16, and request that the Examiner now point out such teaching or allow Claim 16, and those claims that depend therefrom.

 The Applicants also point out that, in the language of Claim 16, the indication occurs after the object and slot have been selected but before a rule is actually violated. This is supported by the use of the past tense for in the word “*selected*” and the future
15 tense in the word “*would*” in “*would violate one or more of the plurality of configuration rules,*” as used in Claim 16. In contrast, in the Office Action of January 27, 2005 the Examiner points to an indication shown in Fig. 3A of Henson that appears to occur after rather than before the object is placed in the slot and a rule violated. The Examiner is referred to page 19 line 17 through page 20 line 1 of the Response to Office Action filed
20 September 15, 2004 for a more detailed explanation of this point.

 It is also the Applicants’ position that Claim 16 should be allowed for at least reasons similar to those discussed above with respect to Claim 1.

Regarding Claim 17.

It is the Applicants' position that Claim 17 should be allowed for at least the same reasons discussed above with respect to Claim 16 from which it depends.

Regarding Claim 23.

5 Claim 23 recites:

23. *The method of claim 16 wherein the configuration layout is representative of a physical layout of the product.*

10 Claim 23 was discussed in the Examiner Interview of March 22, 2005. The Applicants' representative explained that "*physical layout*" referred to the real world layout of a product. The Examiner agreed that the entire interface shown in Fig. 3A of Henson did not teach the limitations of this claim as had been suggested in a previous office action. Instead the Examiner suggested the graphic of a computer shown in the upper left hand corner of Fig. 3A taught a "*configuration layout [that] is representative of a physical layout of the product.*" However, the Applicants respectfully point out that, as recited in Claim 16, from which Claim 23 depends, "*the product configuration layout includ[es] the one or more slots*" into which "*one or more of a plurality of objects are placed.*" The graphic of the computer shown in the upper left hand corner of Fig. 3A of Henson does not include the "*one or more slots*" into which "*one or more of a plurality of objects are placed,*" and therefore cannot teach the "*configuration layout*" of Claim 23. Therefore, the Applicants request that the Examiner point out teachings of the limitations of Claim 23 within the cited art, or allow Claim 23.

Regarding Claims 24-27.

25 It is the Applicants' position that Claims 24-27 should be allowed for at least reasons similar to those discussed above with respect to Claims 1 and 16.

Further, with respect to Claim 24 the Examiner states “Henson further discloses in Figure 3A, an indication that the selected object is not compatible with the current configuration at reference sign 86, and an indication that the selected object is compatible with the selected configuration at reference sign 77.”

5 However, the Applicants respectfully point out that Claim 24 recites
“causing the graphical user interface to indicate that the selected object cannot be placed
in the slot, if placing the selected object in the selected slot would violate the
configuration rule,” and not “an indication that the selected object is not compatible with
the current configuration” as suggested by the Examiner. It is the position of the
10 Applicants that the teaching cited by the Examiner directly contradicts this claim element
because in Henson the item is already in the data field, while according to Claim 24 “the
selected object *cannot* be placed in the slot.”

Regarding Claim 28.

It is the Applicants’ position that Claim 28 is allowable for at least the reasons
15 discussed above with respect to Claim 24, and also Claim 23.

Regarding Claim 29.

Claim 29 recites:

20 29. A method of configuring a product for purchase, the method comprising:
 selecting the product for purchase, the product having a plurality of alternative
 configurations, the plurality of alternative configurations being limited by
 a plurality of configuration rules;
 viewing a first configuration of the plurality of alternative configurations and a
 plurality of objects, within a graphical user interface, the viewed first
 configuration including one or more slots within which at least one of the
25 plurality of objects may be placed;
 specifying a second configuration of the selected product by selecting a first of the
 plurality of objects for placement in a first of the one or more slots, the
 placement of the first of the plurality of objects in the first of the one or
 more slots being limited by a subset of the plurality of configuration rules,

the selection of the first of the plurality of objects being made using the graphical user interface.

Due to time limitations, Claim 29 was not discussed in the Examiner Interview of
5 March 22, 2004. It is the Applicants' position that Claim 29 should be allowed for at least reasons similar to those discussed above with respect to Claim 1.

Further, as discussed in detail in the Response to Office Action filed September 15, 2004, Henson does not appear to teach "*placement of the first of the plurality of objects in the first of the one or more slots being limited by a subset of the plurality of*
10 *configuration rules.*" As stated in those arguments, "Applicants are unable to find any teaching of a subset of configuration rules within Henson," (emphasis added). The Examiner does not appear to have addressed this issue in the Final Office Action of January 27, 2005 and the Applicants believe that the finality of the January 27, 2005 Office Action is, therefore, improper. The Applicants, thus, again request that the
15 Examiner specifically point out a teaching of the use of "*being limited by a subset of the plurality of configuration rules,*" with particular attention to the term "*subset,*" or allow Claim 29 and those claims that depend therefrom.

Regarding Claim 30.

Claim 30 recites:

20 30. *The method of claim 29, wherein the subset of the plurality of configuration rules is determined based on the first configuration.*

It is the Applicants' position that Claim 30 is allowable for at least the reasons discussed above with reference to Claim 29. The Applicants are unable to identify any
25 teaching within Henson concerning determination of a "*subset*" of configuration rules, much less a teaching that this determination is "*based on the first configuration.*" The

Examiner did not respond to these arguments in the Final Office Action of January 27, 2005. The Applicants, therefore, request that the finality of the current office action be removed, and again request that the Examiner specifically point out how Henson teaches all of the limitations of Claim 30, or allow Claim 30.

5 **Regarding Claim 32.**

It is the Applicants' position that Claim 32 is allowable for at least the reasons discussed above with reference to Claim 29, and also Claim 17.

Regarding Claim 33.

It is the Applicants' position that Claim 33 is allowable for at least the reasons
10 discussed above with respect to Claim 1.

35 U.S.C. § 103 Rejections

Claims 4, 5, 11-13 and 18-20 are rejected under 35 U.S.C. 103(a) as being
15 **unpatentable over Henson.**

Regarding Claims 4 and 5.

Claim 4 recites:

20 *4. The method of claim 2, wherein the step of looking up constraints comprises looking up a forward-looking rules table.*

Claim 5 recites:

25 *5. The method of claim 4, wherein the step of storing a new set of constraints comprises storing a new forward-looking rules table.*

It is the Applicants' position that Claims 4 and 5 are allowable for at least the reasons discussed above with reference to Claim 2, from which they depend.

Further, Claims 4 and 5 were not discussed in the Examiner Interview of March 22, 2005 due to time limitations. In the Office Action of June 15, 2004 the Examiner stated:

5 [I]t would have been obvious, to one of ordinary skill, at the time the invention was made to describe the database feature of Henson as having a forward looking rules tables because the data base provides “the data base is provided for dynamically supplying configuration options to the configurator” (Henson, column 3, lines 9-10).

10 The Applicants traverse this statement and again direct the Examiner’s attention to the difference between forward-looking and backward-looking rules. Specifically, in Henson configuration conflicts are detected after they occur. They are, therefore, “backward-looking.” See for example, item 86 on Fig. 3A of Henson. In contrast, the “rules table” recited in Claims 4 and 5 is “*forward-looking*.” This substantial difference, 15 pointed out in the Response to Office Action filed on September 15, 2004, was not addressed in the Final Office Action of January 27, 2005. It is the Applicants position that the finality of the January 27, 2005 Office Action is, thus, improper.

The Applicants, therefore, again bring to the Examiner’s attention the characteristics of “*forward-looking rules table*.”

20 “[F]orward-looking rules table [of the invention] is created based on the components selected by the user, and their placements. Based on each new selection an placement by a user, a new forward-looking rues table is created which lists the constraints on the *next* selection by the user. That is, the forward- 25 looking rules table identifies which slots may or may not be occupied by which particular objects in the next selection by the user. (specification as filed page 11, emphasis in original).

In pointing out this text the Applicants are not attempting to read limitations from the specification into the claims. Rather, the Applicants are attempting to clarify for the 30 Examiner the meaning of “*forward-looking rules table*,” as recited in Claims 4 and 5.

As pointed out previously, the Applicants are unable to find any teaching in Henson of constraints being applied “forward” before a configuration change has been made. It is, therefore, the Applicants’ position that the constraints taught in Henson are not forward looking. There would, therefore, be no reason to employ a “*forward-looking rules table*” as recited in Claims 4 and 5. Rather, the rules taught in Henson appear to be backward-looking rules and, thus, do not necessarily teach a “*forward-looking rules table*.” The Examiner is referred to the Response to Office Action filed September 15, 2004 for a more detailed explanation and for examples of teachings that imply that the rules of Henson are backward-looking.

The Applicants again respectfully request that the Examiner point out teaching of the use of a “*forward-looking rules table*,” as recited in Claims 4 and 5, or allow these claims.

Applicants note that the above arguments also apply to Claims 11, 12 and 18.

Regarding Claim 11.

Claim 11 recites:

*11. The system of claim 9, wherein the user intelligence comprises:
an interpreter for receiving a set of constraints from an inference engine;
a storage for storing the set of constraints;
an implementor for implementing the forward-looking rules stored in the table;
and
an encoder for encoding and sending data regarding a user's current selection
from the plurality of donors and the plurality of receptors to the inference
engine.*

In the Response to Office Action filed September 15, 2004 the Applicants pointed out that the Examiner’s comments did not appear to discuss the “*interpertor*,” “*implementor*,” or “*encoder*” recited in Claim 11. The Applicants, therefore, requested that the Examiner specifically point out those sections of Henson that he believes teach

these elements of Claim 11. In the Office Action of January 27, 2005 the Examiner did not address these issues and merely referred back to the Office Action of June 15, 2004.

The Applicants, therefore, again request that the Examiner address these issues and, because they were not addressed in the Office Action of January 27, 2005, remove the
5 finality of that Office Action.

Further, in the Office Action of January 27, 2005 the Examiner suggested that in Claim 9 “*user intelligence*” is taught by an implied human user of Henson’s system. The Applicants respectfully point out that this suggestion is not consistent with the various attributes of “*user intelligence*” as recited in Claim 11, which depends from Claim 9.

10 The Examiner is referred to the discussion of “*user intelligence*” above with respect to Claim 9 (pages 22-24 of this paper).]

In addition, it is the Applicants position that Claim 11 is allowable for at least the reasons discussed above with respect to Claims 4, 5 and 9.

Regarding Claim 12.

15 Claim 12 recites:

*A system for visually configuring a product from a plurality of selectable components, comprising:
on a client device:*

20 *a visual user interface for displaying the plurality of selectable components and a plurality of slots into which the plurality of selectable components can be placed;*

*a user intelligence communicatively coupled to the visual user interface for determining, by using a forward-looking rules table, the validity of placement of one of the plurality of selectable
25 components into one of the plurality of slots; and*

on a remote host device:

*an inference engine communicatively coupled to the user intelligence, for storing rules and constraints governing placement of the plurality of selectable components, and for generating the forward-looking
30 rules table.*

It is the Applicants' position that Claim 12 should be allowed for at least reasons discussed above with respect to Claims 1, 4, 5 and 9. Specifically, Claim 12 includes "*a plurality of slots*," "*a forward-looking rules table*," and "*a user intelligence*."

Regarding Claim 13.

5 It is the Applicants position that Claim 13 is allowable for at least the reasons discussed above with regard to Claim 12.

Regarding Claim 18:

Claim 18 recites:

10 18. *The method of claim 16 wherein a forward-looking rules table is used to determine if placing the selected object in the selected slot would violate one or more of the plurality of configuration rules.*

It is the Applicants position that Claim 18 is allowable for at least the reasons discussed above with respect to Claim 16, and also Claims 4 and 5.

Regarding Claim 19:

Claim 19 recites:

20 19. *The method of claim 16 wherein a user intelligence stored on the client device is used to determine if placing the selected object in the selected slot would violate one or more of the plurality of configuration rules.*

In the Office Action of January 27, 2005, the Examiner did not respond to the arguments made regarding Claim 19 in the Response to Office Action filed September 15, 2004. Based on this omission the Applicants respectfully request that the Examiner withdraw the finality of the current office action and issue a new office action addressing these arguments, or allow Claim 19.

The Applicants note that Figs. 1 and 2 Henson of appear to teach that constraints are applied at the "On-Line Store" which is a server system not a user system. This

teaches away from the limitations recited in Claim 19, which include “*a user intelligence stored on the client device.*”

Further, with regard to Claim 19 the Examiner is currently suggesting (Examiner Interview and Office Action of January 27, 2005) that “*a user intelligence*” is taught by
5 an implied human user of the Henson system. The Applicants respectfully point out that a human user could not be “*stored on the client device,*” as recited in Claim 19.

The Applicants also believe that Claim 19 is also allowable for at least the reasons discussed above with respect to Claim 16.

Regarding Claim 20.

10 It is the Applicants position that Claim 20 is allowable for at least the reasons discussed above with regard to Claim 16.

Claims 10, 21, 22 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of King et al. US Patent 6,161,114 (filed 4/14/1999).

15 **Regarding Claim 10.**

It is the position of the Applicants that Claim 10 is allowable for at least the reasons discussed above with respect to Claim 9, from which it depends.

Further, in the Office Action of January 27, 2005, the Examiner did not respond to the arguments made regarding Claim 10 in the Response to Office Action filed
20 September 15, 2004. Based on this omission the Applicants respectfully request that the Examiner withdraw the finality of the current office action and issue a new office action addressing these arguments, or allow Claim 10.

Specifically, in the Response to Office Action filed September 15, 2004, the

Applicants stated:

5 Applicants are unable to identify teaching of “*donors*” or “*receptors*” (as distinguished from objects and slots) in either King or Henson. Applicants request that the Examiner specifically point out these teachings or allow Claim 10.

This argument was not addressed in the Office Action of January 27, 2005.

Regarding Claim 22.

10 It is the position of the Applicants that Claim 22 is allowable for at least the reasons discussed above with respect to Claim 16, from which it depends.

Further, in the Office Action of January 27, 2005, the Examiner did not respond to the arguments made regarding Claim 22 in the Response to Office Action filed September 15, 2004. Based on this omission the Applicants respectfully request that the
15 Examiner withdraw the finality of the current office action and issue a new office action addressing these arguments, or allow Claim 22.

Specifically, in the Response to Office Action filed September 15, 2004, the

Applicants stated:

20 Applicants are unable to identify teaching of “*wherein causing the graphical user interface to indicate that the selected object cannot be placed in the selected slot includes not allowing the dragging one of the plurality of object to be dropped in the one of the one or more slots*,” as recited in Claim 22, in either King or Henson. Applicants request that the Examiner specifically point out these teachings or allow Claim 22. (emphasis added)

25 This argument was not addressed in the Office Action of January 27, 2005.

Regarding Claims 21 and 31.

It is the Applicants position that Claims 21 and 31 are allowable for at least the reasons discussed above with regard to Claims 16 and 29 from which they depend, respectively.

5 Regarding Claim 35.

Claim 35 recites:

35. *(Previously Presented) The method of claim 16, wherein causing the graphical interface to indicate that the selected object cannot be placed in the selected slot occurs while attempting to place the selected object in the selected slot.*

10

With regard to Claim 35 the Examiner states “the claim is directed toward method for the system of claim 10 and is rejected using the same rationale.” The Applicants traverse this statement. Specifically, Claim 35 includes the limitation “*while attempting to place the selected object in the selected slot,*” which is not found in Claim 10. The Applicants, therefore, request that the Examiner specifically address this limitation, or allow Claim 35.

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Applicants believe that all pending claims are allowable and respectfully request that the Examiner issue a Notice of Allowance. Should the Examiner have questions, the

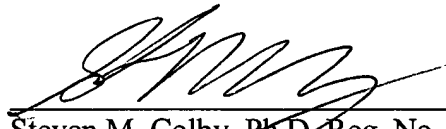
5 Applicants' undersigned representative may be reached at the number provided.

The Applicants thank the Examiner for the Examiner Interview of March 22, 2005.

Respectfully submitted,
Christopher E. Axe et al.

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